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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,231	01/18/2006	Reinhold Ott	40770-000164/US	8372
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EXAMINER				
LU, SHIRLEY				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,231

Applicant(s)

OTT, REINHOLD

Examiner

SHIRLEY LU

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

a. Applicant argues starting on page(s) 9, that the prior art does not specifically disclose an “elastically deformable material” “the body will not spring back to its undeformed shape.”

In response, as to “elastically deformable material,” the limitation is met by the prior art, and the broadest reasonable interpretation has been applied to the claims, such as capable for change/expansion/contraction, not rigid or constricted. Limitations from the specification have not been read into the claims.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant rely (i.e., “the body will not spring back to its undeformed shape”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Please also see action below.

b. Applicant argues starting on page(s) 9, that the prior art does not specifically disclose “the first retaining area and the second retaining area include the same material.”

In response, the prior discloses “the first retaining area and the second retaining area include the same material” since the first retaining area is the top area of apparatus 60 that is of material 62, and the second retaining area is the bottom area of

apparatus 60 that is of material 62, both of which include the same material, 62. Please also see action below.

c. Applicant argues starting on page(s) 11, that the prior art does not specifically disclose "the first retaining area and the second retaining area include the same material."

In response to applicant's argument that one would not have modified the prior art with Jagger, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Jagger is at least reasonably pertinent to the particular problem with which the applicant was concerned. Specifically, Jagger discloses a conventional use of a capacitive switch and an optical sensor for sensing purposes. The prior art rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim(s) 1, 7-18, 20, 22, 25-26 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Leyden (5565848).

As to claim(s) 1, Leyden discloses:

Retaining component for securing an item from theft, the retaining component comprising:

a first retaining area for fastening the retaining component to a fastening component; and at least one second retaining area in for fastening the retaining component to the item, the second retaining area being designed to be more easily deformable than the first retaining area (fig. 3, 6, 12; [2, 40-51]; [3, 34-39]),

wherein the retaining component is attachable to the item using a double-sided adhesive tape and includes an elastically deformable material, the double-sided adhesive tape being ductile ([3, 33-39]; [5, 12-18]).

As to claim(s) 7, Leyden discloses:

the first retaining area and the second retaining area include the same material (fig. 3, 6, 12; [7, 31-48]).

As to claim(s) 8, Leyden discloses:

the first retaining area and the second retaining area are an integral part of the retaining component (fig. 3, 6; 12; [2, 40-51]; [3, 34-39])).

As to claim(s) 9, Leyden discloses:

the material thickness of the second retaining area is less than the material thickness of the first retaining area (fig. 3, 6; 12; [7, 31-48]).

As to claim(s) 10, Leyden discloses:

in the second retaining area an adhesive layer is provided for attaching the retaining component to the item([3, 33-39]; [5, 12-18]).

As to claim(s) 11, Leyden discloses:

the attachment of the retaining component to the fastening component is detachable (fig. 3, 12; [6, 8-22]; [7, 9-19]).

As to claim(s) 12, 13, Leyden discloses:

the retaining component comprises sensor elements for monitoring proper fastening of the retaining component to the item ([3, 43] to [4, 14]).

As to claim(s) 13, Leyden discloses:

the sensor elements are designed as electric sensor elements ([3, 43] to [4, 14]).

As to claim(s) 14, 25 Leyden discloses:

electric connecting devices are provided for electrically connecting the sensor elements to an evaluation circuit ([3, 43] to [4, 14]).

As to claim(s) 15, 26, Leyden discloses:

an evaluation circuit is provided in the retaining component ([3, 43] to [4, 14]).

As to claim(s) 16, Leyden discloses:

mechanical connecting devices are provided for connecting the retaining component to the fastening component (fig. 3, 12; [6, 8-22]; [7, 9-19]).

As to claim(s) 17, Leyden discloses:

the connecting devices are designed as wires or cables (fig. 3, 12; [6, 8-22]; [7, 9-19]).

As to claim(s) 18, Leyden discloses:

the connecting devices are integratable in the fastening component (fig. 3, 12; [6, 8-22]; [7, 9-19]).

As to claim(s) 20, Leyden discloses:

a fastening component connected to the retained component (fig. 3) wherein the evaluation circuit is arranged in the fastening component ([3, 43] to [4, 14]).

As to claim(s) 22, Leyden discloses:

Alarm system comprising a retaining component as claimed in claim 1 and a fastening component for fastening the retaining component (fig. 3, 6, 12; [3, 43] to [4, 14]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 2-3, 5, 23 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Leyden (5565848) in view of Hadfield (6268795).

As to claim(s) 2,

Leyden discloses: The part of the body can be made from a deformable material that can be conformed to an underlying surface on an article to be monitored. The first structure may be an adhesive that acts between the first surface and an underlying surface on an article to be monitored [3, 34-38].

The above art/combination above does not expressly teach an expansion of the double-sided adhesive tape leads to a roughly simultaneously occurring detachment of the same from the retaining component and the item.

Hadfield discloses: when an attempt is made to remove it from the surface, the center section 3 may overcome the adhesive bond and pull away from the surface but the head section 2 will stretch before the adhesive bond is broken. The resulting stretching of the conductive track 5 produces an altered resistive value which is detected by the monitoring circuit. The rate of change of the resistive value, and/or the magnitude of the change would be of a different order compared to resistive changes caused by temperature variations and can thereby be used to trigger an alarm [3, 34-37].

It would have been obvious to one of ordinary skill in the art to modify the above art/combination to teach an expansion of the double-sided adhesive tape leads to a roughly simultaneously occurring detachment of the same from the retaining component and the item, so as to detect tampering with a system by monitoring the properties of a adhesive material connected to the device.

As to claim(s) 3,

Leyden discloses:

at least one of the expansion and the detachment of the double-sided adhesive tape triggers an alarm ([3, 34-37]; see also claim 22).

As to claim(s) 5, 23,

Hadfield discloses:

the double-sided adhesive tape can be pulled off laterally using a force that is applied on the adhesive tape and that acts upon it roughly in the plane of the adhesive tape [3, 27-37].

3. Claim(s) 4, 6 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Leyden (5565848) in view of Zimmerman (6436527).

As to claim(s) 4,

Leyden discloses: The part of the body can be made from a deformable material that can be conformed to an underlying surface on an article to be monitored. The first structure may be an adhesive that acts between the first surface and an underlying surface on an article to be monitored [3, 34-38].

The above art/combination above does not expressly teach the double-sided adhesive tape is equipped with a non-adhesive handling area.

Zimmerman discloses the double-sided adhesive tape is equipped with a non-adhesive handling area [2, 44-46].

It would have been obvious to one of ordinary skill in the art to modify the above art/combination to teach the double-sided adhesive tape is equipped with a non-adhesive handling area, so as to protect the adhesively until desired use.

As to claim(s) 6,

Leyden discloses: The part of the body can be made from a deformable material that can be conformed to an underlying surface on an article to be monitored. The first structure may be an adhesive that acts between the first surface and an underlying surface on an article to be monitored [3, 34-38].

The above art/combination above does not expressly teach the double-sided adhesive tape involves a product from Tesa company, which is distributed under the term Power Strip.

Zimmerman discloses the double-sided adhesive tape involves a product from Tesa company, which is distributed under the term Power Strip [2, 43-46]. It would have been obvious to one of ordinary skill in the art to modify the above art/combination to teach the double-sided adhesive tape involves a product from Tesa company, which is distributed under the term Power Strip, so as to utilize adhesive material that has a balance between plasticity and elasticity.

4. Claim(s) 19, 21 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Leyden (5565848) in view of Hamlin (5964353).

As to claim(s) 19, 21,

Leyden discloses: a fastening component connected to the retained component (fig. 3).

The above art/combination above does not expressly teach wherein the fastening component includes a winding device for the connecting devices; the electric connecting devices are contactable via ball contacts in the winding device.

Hamlin discloses a winding device, and ball contacts in the winding device [10, 6 et seq].

It would have been obvious to one of ordinary skill in the art to modify the above art/combination to teach wherein the fastening component includes a winding device for the connecting devices; the electric connecting devices are contactable via ball contacts in the winding device, so as to protect electronic circuitry and save space.

5. Claim(s) 24, 27-28 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Leyden (5565848) in view of Jagger (5433391).

As to claim(s) 24,

Leyden discloses a sensor and electrical circuit [3, 59 et seq].

The above art/combination above does not expressly teach the sensor elements are designed as at least one of capacitive switches, and as optical sensor elements.

Jagger discloses the sensor elements are designed as at least one of capacitive switches and optical sensor elements ([5, 50-62]).

It would have been obvious to one of ordinary skill in the art to modify the above art/combination to teach the sensor elements are designed as at least one of capacitive switches, and as optical sensor elements, so as to utilize alternative or additional sensing means to monitor a system.

As to claim(s) 27, Leyden discloses:

electric connecting devices are provided for electrically connecting the sensor elements to an evaluation circuit ([3, 43] to [4, 14]).

As to claim(s) 28, Leyden discloses:

an evaluation circuit is provided in the retaining component ([3, 43] to [4, 14]).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Lu whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SL

/Daniel Wu/
Supervisory Patent Examiner, Art Unit 2612